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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,430	01/26/2004	Guillermo J. Tearney	34834/US/2-475387-20	1546
7590 GARY ABELEV DORSEY & WHITNEY LLP 250 PARK AVENUE NEW YORK, NY 10177		12/11/2009	EXAMINER WINAKUR, ERIC FRANK	
			ART UNIT 3768	PAPER NUMBER
			MAIL DATE 12/11/2009	
			DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/765,430	TEARNEY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eric F. Winakur	3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 August 2009.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,5-7,9,11-31,33-36 and 40-44 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 1,9 and 12-17 is/are allowed.  
 6) Claim(s) 2,5-7,11,18-31,33-36 and 40-44 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

2. Claims 2, 5 - 7, 11, 18 - 31, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 2 it is unclear what further limitation is set forth, as the base claim already includes an optical/light source. With regard to claim 11, it is unclear what structural limitation of the apparatus is set forth, as the claim merely describes how a sample would interact with the light; there is no indication in the claim as set forth that the processing done by the imaging system is affected by this limitation. With regard to claim 18, the phrase "the radiation source" (line 6) lacks antecedent basis. With regard to claim 19, it is unclear what further limitation of the method is set forth, as the claim merely describes how a sample would interact with the light. With regard to claims 24 and 30, it is unclear how the limitations of the last three lines of the claim affect the scope of the "causing a performance" step, to which they seem to most closely relate. With regard to claims 25 and 31, it is unclear what further limitation of the method is set forth, as the claim merely describes how a sample would interact with the light. With regard to claims 27 and 33, by reciting "a light source" it is unclear if Applicant intends to set forth that a processing set interacts with an additional element or if the recitation is meant to refer to the "radiation source" of the base claim.

***Claim Rejections - 35 USC § 101***

3. The rejection of claims 24 - 31, and 33 - 35 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter is hereby maintained.

***Claim Rejections - 35 USC § 102***

4. Claims 36 and 40 - 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Izatt for the reasons of record.

***Response to Arguments***

5. Applicant's arguments filed 8/19/09 with regard to claims 24 - 31, 33 - 36, and 40 - 43 have been fully considered but they are not persuasive. With regard to claims 24 - 29 and 30, 31, and 33 - 35 rejected under 35 U.S.C. 101, it is noted that Applicant argues that claims directed to " a computer-accessible storage medium" or a "software arrangement" are statutory, since the claim details meet the machine-or-transformation test of *In re Bilski*. However, such a position is not persuasive. The machine-or-transformation test is applied to method claims. However, neither claim 24 nor claim 30 fall into this category. Rather, claim 24 is drawn to a "computer-accessible storage medium" and claim 30 is drawn to a "software arrangement". As detailed in the prior Office action, a computer readable medium must be claimed or explicitly defined to cover only tangible embodiments or else is considered to be drawn to non-statutory subject matter since the broadest reasonable interpretation of this phrase includes non-transitory embodiments, such as memory elements (ROM, RAM) and memory media (CDs) as well as transitory embodiments, such as carrier waves encoded with the software steps. However, transitory forms of signals are not statutory (*In re Nuijten*, 84

USPQ2d 1495). A claim that covers both statutory and non-statutory embodiments embraces subject matter that is improperly directed to non-statutory subject matter. Software, as set forth in claim 30, is merely drawn to an abstract idea (functional descriptive material), and does not fall into one of the statutory categories of invention (see MPEP 2106.01).

With regard to the prior art rejections of claims 36 and 40 - 44, Applicant alleges that Izatt does not disclose processing of unidimensional data and is concerned with multi-dimensional data processing. However, as detailed in the prior action, Izatt (column 19, line 49 - column 22, line 11) details an “A-scan” (unidimensional) measurement and analysis. Izatt details throughout the specification embodiments relying on low-coherence spectroscopy. Even if Izatt analyzes several of the A-scans to obtain multi-dimensional information, the claim language does not exclude such an arrangement from meeting the claim limitations, as set forth.

***Allowable Subject Matter***

6. Claim 1, 9, and 12 - 17 are allowed.
7. Claims 2, 5 - 7, 11, and 18 - 23 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F. Winakur whose telephone number is 571/272-4736. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571/272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric F Winakur/  
Primary Examiner, Art Unit 3768